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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,361	09/22/2003	Denis M. Boyle	6794A-000009/US/CPA	4467
30593	7590	01/11/2008		
HARNES, DICKY & PIERCE, P.L.C.			EXAMINER	
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			ART UNIT	PAPER NUMBER
			1656	
			MAIL DATE	DELIVERY MODE
			01/11/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,361

Applicant(s)

BOYLE ET AL.

Examiner

Anand U. Desai, Ph.D.

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 8, 12, 15-17, 20, 23, 26, 31, 34, 37, 40, 43, 54 and 205-218 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 206 and 207 is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 12, 15-17, 20, 23, 26, 31, 34, 37, 40, 43, 54, 205, 208, and 211-217 is/are rejected.
- 7) ☒ Claim(s) 209, 210 and 218 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Amendment filed on October 24, 2007. Claim 51 has been cancelled. New claim 218 has been added.
2. Claims 1-5, 8, 12, 15-17, 20, 23, 26, 31, 34, 37, 40, 43, 54, and 205-218 are currently pending and are under examination.

Withdrawal of Rejections

3. The rejection of claims 1-5, 8, 12, 15-17, 20, 23, 26, 31, 34, 37, 40, 54, 205, 208, 216, and 217 are rejected under 35 U.S.C. 112, first paragraph, scope of enablement is withdrawn based on the amendment to the claims.

Pending Objections and Rejections

Oath/Declaration

4. A new oath or declaration is required because the oath does not identify the mailing address of each inventor. The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration is required. The new oath or declaration must properly identify the application of which it is to form a part, preferably by application number and filing date in the body of the oath or declaration. See MPEP §§ 602.01 and 602.02.

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business

address. The mailing address should include the ZIP Code designation. The mailing address may be provided in a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

Claim Objections

5. Claims 43, 208, 209 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1, 205, and 218. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

6. Claims 209, 210, and 218 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-5, 8, 12, 15-17, 20, 23, 26, 31, 34, 37, 40, 43, 54, 205, 208, and 211-217 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims are rejected under 35 U.S.C. 112, 1st paragraph, Written Description, because the specification does not disclose a representative number of protein growth hormone antagonists, which would lead one skilled in the art to conclude that applicant was in possession of the claimed invention. The claims drawn to the human growth hormone antagonist B-2036 is sufficiently described. The MPEP states that the purpose of the written description requirement is to ensure that the inventor had possession, at the time the invention was made, of the specific subject matter claimed. The courts have stated:

"To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that 'the inventor invented the claimed invention.'" *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997); *In re Gostelli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966." *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

Further, for a broad generic claim, the specification must provide adequate written description to identify the genus of the claim. In *Regents of the University of California v. Eli Lilly & Co.* the court stated:

"A written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula, [or] chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *Fiers*, 984 F.2d at 1171, 25 USPQ2d 1601; *In re Smythe*, 480 F.2d 1376, 1383, 178 USPQ 279, 284985 (CCPA 1973) ("In other cases, particularly but not necessarily, chemical cases, where there is unpredictability in performance of certain species or subcombinations other than those specifically enumerated, one skilled in the art may be found not to have been placed in possession of a genus ...") *Regents of the University of California v. Eli Lilly & Co.*, 43 USPQ2d 1398.

MPEP § 2163 further states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure of the sequence, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163 does state that for a generic claim the genus can be adequately described if the disclosure presents a sufficient number of representative species that encompass the genus. If the genus has a substantial variance, the disclosure must describe a sufficient variety of species to reflect the variation within that genus. See MPEP § 2163. Although the MPEP does not define what constitute a sufficient number of representative species, the courts have indicated what do not constitute a representative number of species to adequately describe a broad generic. In *Gostelli*, the courts determined that the disclosure of two chemical compounds within a subgenus did not describe that subgenus. *In re Gostelli*, 872, F.2d at 1012, 10 USPQ2d at 1618.

The factors considered in the Written Description requirement are (1) *level of skill and knowledge in the art*, (2) *partial structure*, (3) *physical and/or chemical properties*, (4) *functional characteristics alone or coupled with a known or disclosed correlation between structure and function*, and the (5) *method of making the claimed invention*. Disclosure of any combination of such identifying characteristics that distinguish the claimed invention from other materials and would lead one of skill in the art to the conclusion that the applicant was in possession of the claimed species is sufficient." MPEP § 2163.

In the instant case, the claims are drawn to a process for decreasing a level of aggregate of pegylated protein isoforms, wherein the pegylated protein is a growth hormone antagonist, said process comprising the steps of providing pegylated protein isoforms and separating said

pegylated protein isoforms by anion exchange chromatography using an anion exchange resin under sufficient conditions to decrease said level of said aggregate, where said level of said aggregate is less than 6% by weight based on the total weight of said isoforms and said aggregate, and wherein said pegylated protein isoforms comprises one or more of the isoforms PEG-1, PEG-2, PEG-3, PEG-4, PEG-5, PEG-6, PEG-7, PEG-8, and PEG-9 and any aggregate, trisulfide impurity and des-phe impurity thereof.

As stated *supra*, the MPEP states that written description for a genus can be achieved by a representative number of species within a broad genus. Claims are broadly generic to all possible protein growth hormone antagonists encompassed by the claims. The possible variations are enormous to any class of protein antagonists. Since the MPEP states that if a biomolecule is described only by a functional characteristic, without any disclosed correlation between function and structure, it is "not sufficient characteristic for written description purposes, even when accompanied by a method of obtaining the claimed sequence." MPEP § 2163. Here, though the claims may recite some functional characteristics, the claims lack written description because there is no disclosure of a correlation between function and structure of the genus of protein antagonists beyond those disclosed in the examples in the specification. Moreover, the specification lacks sufficient variety of species to reflect this variance in the genus since the specification does not provide any examples of non B-2036 pegylated protein antagonists.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736, F.2d 1516, 1521, 222 USPQ 369, 372-73 (Fed. Cir. 1984) (affirming rejection because the

specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate.") Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of the claims and does not reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the entire scope of the claimed invention.

Conclusion

9. Claims 1-5, 8, 12, 15-17, 20, 23, 26, 31, 34, 37, 40, 43, 54, 205, 208, and 211-217 are rejected.
10. Claims 209, 210 and 218 are objected.
11. Claims 206 and 207 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anand U. Desai, Ph.D. whose telephone number is (571) 272-0947. The examiner can normally be reached on Monday - Friday 9:00 a.m. - 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Kathleen Kerr Bragdon can be reached on (517) 272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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January 6, 2007
2008 AD.

AD
/Anand Desai/
Patent Examiner
Art Unit 1656